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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/346,353 07/02/99 ANGELOPOULOS

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IM52/0214

EXAMINER

YDON, T

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

02/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/346,353

Applicant(s)

Angelopoulos et al

Examiner

T. Yoon

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12-4-00
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-45 is/are pending in the application.
- Of the above claim(s) 17-19, 21, 26-39 and 43-45 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16, 20, 22-25 and 40-42 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16, 20, 22, 23 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,969,024. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly recited additive (claim 1), second material (claim 7) and plasticizer (claim 12) encompass the siloxane of the patent as evidenced by claim 4, Siloxanes for example.

The obviousness-type double patenting is maintained, and applicant statement, the submission of the Terminal Disclaimer in the future, is acknowledged.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 24 and 40-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 24 reciting further presence of monomer and an oxidant in addition to an admixture of a solvent, an additive and a polymer does not have support in the originally filed specification, and thus constitutes New Matter. Applicant states in the response, "[i]f an oxidative polymerization were done there would be monomers and oxidants in the solution", which admits an oxidative polymerization. If this is the case, the Examiner has clearly indicated that such method will not be examined in the last Office Action since said method is distinct from the claim 1, a treatment of a polymer.

The rejection with respect to claims 40-42 is maintained for reason of record and following. Contrary to applicant's assertion, the specification does not adequately describe that the oxidant is a plasticizer and provides local mobility to a polymer. The use of said oxidant such as ammonium peroxydisulfate is seen at line 16, page 15 of the specification, however, again it is directed to an oxidative polymerization, not a treatment of a polymer as discussed above also.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478), Ikkala et al (US 5,520,852) or Cao et al (US 5,232,631).

Rejection is maintained for reson of record, and following.

Contrary to applicant's assertion, the instant claim does not recite any particular method of forming at least one crystal grain. The cited art show a treatment of conducting polymers by plasticizers or solvents as in the instant invention. Thus, the process recited in Han, Ikkala and Cao inherently yields the recited at least one crystal grain and material having isotropic electrical conductivity, and applicant failed to show otherwise.

Claims 1-16, 20, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478).

Rejection is maintained for reson of record, and following.

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Contrary to applicant's assertion, the examiner did not acknowledge that Han does not teach using a solvent. Rather, Han teaches the instant invention in the example 6, as pointed out in the last Office Action, wherein the use of a plasticizer (tripropylamine) and a solvent (N-methyl pyrrolidinone) is taught. Note that a polyaniline would not substantially soluble in said plasticizer, tripropylamine, or other plasticizers taught by Han at col. 6, line 21 to col. 7, line 66 as evidenced by Han's teaching, a plasticizing agent will **soften** and increas the flexibility of all or part of the polyaniline, at col. 6, lines 27-29. It dose not teach said plasticizing agent will dissolve said polyaniline.

Claims 1-16, 20, 22, 23 and 25 are rejected under 35 U.S.C. 103(a) as obvious over Han (US 5,171,478) in view of Cao et al (US 5,232,631).

Rejection is maintained for reson of record, and of above.

Claims 1-16, 20, 22, 23 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cao et al (US 5,232,631).

Rejection is maintained for reson of record, and following.

Contrary to applicant's assertion, the examiner did not acknowledge that Cao does not teach using a solvent. Rather, for example, Cao eaches a method of plasticizing polyaniline by employing a plasticizer, p-dodecylbenzene sulfonic acid (DBSA), and a solvent in the example 4.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thr from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for this Group is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

THY/February 12, 2001



TAE H. YOON
PRIMARY EXAMINER